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J	IAF-14
EXAMINER	
FORD, J	
ART UNIT	PAPER NUMBER
1202	6
DATE MAILED: 12/10/92	

 This is a communication from the examiner in charge of your application
COMMISSIONER OF PATENTS AND TRADEMARKS

- ☐ This application has been examined
 ☐ Responsive to communication filed on _____
 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire _____ month(s), 30 days from the date of this letter.
 Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 3--5, 7 and 10--20 are pending in the application.
- Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☐ Claims _____ are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 3--5, 7 and 10--20 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable, ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner, ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved, ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

MINER'S ACTION

Art Unit 1202

The claims in the application are claims 3-5,7 and 10-20.

Claims 3-5,7,10,19 and 20 are directed to compounds in class 544 and a pharmaceutical method and composition in class 514 (group A).

Claims 11-18 are directed to methods of separation of a racemic mixture to obtain the substantially pure *Cis* isomer (group B).

Claims 11-18 demonstrate that the racemic separation into (+) and (-) isomers may be accomplished by chiral HPLC (claim 13) or by enzyme - mediated enantio selective catabolism.

Therefore, restriction between group A and group B under 35 USC 121 is required, and is considered proper, as the claims indicate more than one method of preparation; MPEP 806.05(f).

These distinct inventions have acquired separate status in the art and will support separate patents. Accordingly, restriction for examination purposes as indicated is considered proper; 35 USC 121; 37 CFR 1.141 and 37 CFR 1.142.

Applicants' response must include a provisional election, even if the requirement be traversed, see 37 CFR 1.142 and 1.143.

An "Abstract of the Disclosure", on a separate, ^{single} sheet of paper, limited to itself, is requested.

Applicant is reminded of the proper language and format of an Abstract of the Disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the

Art Unit 1202

range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said", should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

If the processes of group B, i.e. claims 11-18, are elected, election of a particular, singular, method is required.

This restriction requirement is being written as previous experience has indicated that ~~with~~ Foreign applicants and the inherent time delays, applicants representative is better able to make an informed, correct, election of the invention applicants would wish to have prosecuted here, if applicants are given the opportunity to see the restriction requirement laid out, and given the time to make an informed decision.



JOHN M. FORD
PRIMARY EXAMINER
GROUP 120